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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,623	07/21/2000	Rene Chiocca	193618US3XPC	2666

116 7590 10/20/2003

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EXAMINER
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BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582623

Applicant(s)

ChioCCA et al

Examiner

Behren

Group Art Unit

3641

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/4/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 17-30, 33-36 is/are pending in the application.
- Of the above claim(s) 22-28, 30 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 17-21, 29, 33-36 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The elected species (which is carried forward in an RCE) is specie D (the Fig. 5 embodiment) (note the 4/3/01 Office action and the 5/3/01 response).

The Fig. 5 embodiment does not have "clamping elements" that are elastic (Fig. 2a shows elastic clamping elements (spring leaves 10)).

3. Claims 17-21, 29, 33-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite and incomplete, particularly as to what all is meant by and is encompassed by the term "transport device".

Applicant argues in the 9/4/03 response that the term "transport device" means a device to carry the nuclear fuel between a storage facility and a location where the fuel is used.

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The examiner disagrees.

Applicants so called "transport device" (element 1 in Fig. 1) is not by itself, capable of transporting anything, i.e., it cannot by itself, convey, move, etc., anything (including nuclear fuel) from one location to another.

Applicants element 1 in Fig. 1 is only capable of holding something (such as nuclear fuel).

The only way in which applicants element 1 in Fig. 1 can itself be moved, conveyed or transported from one location to another, is if it is placed on a transport means such as a truck, train or ship which is capable of transporting applicants container (element 1 in Fig. 1) from one location to another.

While an applicant can be his own lexicographer, no term can be given a meaning repugnant to the usual meaning of the term. See MPEP 2173.05 (a).

Thus, to state that applicants container 1 in Fig. 1 is a "transport device" which is capable of conveying nuclear fuel from one location to another is considered as giving this term a meaning, repugnant to its usual meaning.

Applicants container 1 in Fig. 1 may be transportable, but it itself is not a "transport device" which can convey nuclear fuel from one location to another.

There is no proper antecedent basis in claim 34 for the term "clamping elements".

4. Claims 17-21, 29, 33-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one

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skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no adequate description nor enabling disclosure of what all is meant by and is encompassed by the term "transport device".

There is no enabling disclosure of how and in what manner, applicants container 1 in Fig. 1 is by itself, capable of transporting or conveying, nuclear fuel from one location to another.

Note also, the discussion of this issue in section 3 above.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-21 are rejected under 35 U.S.C 102(b) as being clearly anticipated by any of Taylor, Cornic or Butler et al, for the reasons set forth in section 3 of the 3/3/03 Office action.

Applicants arguments are unpersuasive of any error.

The examiner does not agree that applicants container 1 in Fig. 1 is itself, a "transport device" capable of conveying nuclear fuel from a storage facility to a location where the fuel is used.

The "containers" of any of the references are still considered movable (transportable) for the reasons set forth in said section 3 of the 3/3/03 Office action.

Note also, the discussion of the term "transport device" in section 3 above.

8. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornic or Butler et al as applied to claims 17-21 above, and further in view of Taylor.

As indicated previously, Taylor shows that it is known in the art that a nuclear reactor can either be "stationary" or movable (transportable) when used on a ship (pages 2 and 6 of Taylor refer to the nuclear reactor shown in Fig. 1 of Taylor, as being on a ship).

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Accordingly, it would have been prima facie obvious to have utilized the nuclear reactors of either primary reference on a ship in view of the above referenced teachings of Taylor showing such to be an art recognized alternative to being stationary.

Since applicant admits on page 4 of the 12/6/02 response that "in Butler et al., substantially the same arrangement as in Taylor is described", the system of Butler et al is also inherently capable of being used on a ship by applicants own admissions.

9. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Stelle, Burger or Japan 0041692, in view of Butler et al, for the reasons set forth in section 4 of the 3/3/03 Office action.

10. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Stelle, Burger or Japan 0041692, in view of Butler et al as applied to claims 17-20 above, and further in view of Taylor, for the reasons set forth in section 8 above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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Behrend/kn  
September 29, 2003



HARVEY E. BEHREND  
PRIMARY EXAMINER